



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Matt Morano, et al.

Serial No.: 10/700,406

Filed: November 4, 2003

For: **DISTRIBUTED TRADING BUS
ARCHITECTURE**

Art Unit: 3621

Examiner: Not Yet Assigned

COMMISSIONER FOR PATENTS
PO BOX 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR 1.47(a) TO ACCEPT FILING BY JOINT
INVENTORS ON BEHALF OF THEMSELVES AND JOINT INVENTOR
WHO REFUSES TO JOIN IN APPLICATION**

DEAR SIR:

Applicants' hereby petition the Office under 37 CFR 1.47(a) to accept the filing of the above-identified patent application on behalf of themselves and of a joint inventor, Mr. Kai Neumann, who has refused to join in the application.

STATEMENT OF FACTS

1. My name is Stuart T. Langley. I am a partner with Hogan & Hartson LLP who represents New York Mercantile Exchange, Inc. (NYMEX) in patent and intellectual property matters.

2. Mr. Kai Neumann was acting at various times during the conception and reduction to practice of inventions claimed in U.S. Patent application 10/700,406 as either a consultant for NYMEX or as an employee of NYMEX.

3. Neumann is an individual who resides at 785 West End Avenue, Apartment 17A, New York, New York 10025.

4. During August of 2003 Mr. Kai Neumann participated in the preparation of U.S. Patent application 10/700,406.

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5. On September 19, 2003 I presented all of the joint inventors, including Mr. Neumann, with a draft of the patent application and a declaration of inventorship. Mr. Neumann did not sign the declaration.

6. Subsequently, a dispute arose between Mr. Neumann and NYMEX and Mr. Neumann was terminated later in September, 2003.

7. On November 4, 2003 I filed the above-identified patent application with a partially executed declaration that included signatures of all joint inventors except Mr. Neumann, whose signature block was left blank.

8. On April 27, 2004 I provided a copy of a declaration for Mr. Neumann's signature to Mr. Neumann's attorney, Matt Neel, with request that Mr. Neumann sign and return the declaration of inventorship. Mr. Neel responded on April 30, 2003 with a request for a copy of corresponding patent specification.

9. On May 21, 2004 I provided Mr. Neumann, through his attorney Mr. Neel, a confidentiality agreement governing the use of the patent specification during Mr. Neumann's review.

10. On June 22, 2004 Mr. Neumann was again requested, through his attorney Mr. Neel, whether he would sign the declaration of inventorship.

11. On July 2, 2004 Mr. Neel sent an unsigned letter addressed to my partner, Mr. Peter W. Smith indicating that Mr. Neumann would not "participate in the patenting process" for the above-identified patent application. See Exhibit A attached to this statement.

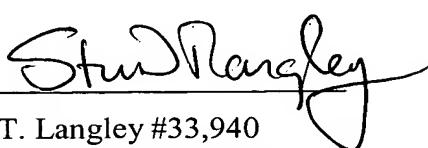
12. Although I do not wish to speak for Mr. Neumann, from the July 2, 2004 letter it would appear that the reasons for refusing to join in the patent application relate to a general lack of trust for NYMEX and a dispute as to ownership of the invention.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of

Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date: 7/12/2004

BY: 

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July 2, 2004

By E-Mail and First-Class Mail

Peter W. Smith, Esq.
Hogan & Hartson, LLP
875 Third Avenue
New York, NY 10022

Dear Mr. Smith:

I write with regard to NYMEX's request that my client participate in the patenting process for a distributed trading bus.

History has shown that NYMEX does not consider itself bound by confidentiality agreements. Further, it is unwise to enter into any confidentiality agreement with NYMEX, as it is likely that the disclosure of any information by NYMEX to Mr. Neumann will be made solely as a pretext for further litigation. It seems likely that NYMEX's purpose in disclosing information to Mr. Neumann, with or without a confidentiality agreement, is to set the stage for a subsequent infringement suit against him.

Furthermore, Mr. Neumann has grave concerns about NYMEX's attempt to incorporate and patent material that actually belongs to him and Codeland, Inc. As you are no doubt aware, my clients have made claims against NYMEX for its misappropriation of their trade secret material. If Mr. Neumann's concerns are borne out, it may be that he will be forced to oppose this patent, not support it. We do not intend to allow NYMEX to profit further from its theft of Mr. Neumann's intellectual property.

If you know of any way around my clients' dilemma, please feel free to contact me.

Very truly yours,

Matthew J. Neel